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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,057	04/27/2001	Anthony S. Volpe	VAK-PT005.1	2706

3624 7590 12/09/2005

VOLPE AND KOENIG, P.C.  
UNITED PLAZA, SUITE 1600  
30 SOUTH 17TH STREET  
PHILADELPHIA, PA 19103

EXAMINER

FLANDERS, ANDREW C

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/844,057	VOLPE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew C. Flanders	2644	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-19,21,22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-19,21,22 and 24-28 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's arguments, see the arguments regarding the validity of the cited RWM reference in the previous action, filed 21 November 2005, with respect to the rejection(s) of claim(s) 1 – 24 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gorbet (U.S. Patent 6,072,480).

While it cannot be proven that the date given on the Raspberry world Music webpage precede Applicant's priority date, Examiner maintains the position that the knowledge taken from this cited document was notoriously well known in the art at the time of the invention. Creating a mix CD (or tape or any other audio mix) for a person or group depending on their taste in music and an event (such as a birthday as stated in RWM) was very well known as it is more or less common knowledge and thus not patentable. While minor nuances in the invention may separate it from a mix CD as stated above, it is the Examiner's position that the currently presented claims (claims presented as of 21 November 2005) are broad enough in scope to read upon a mix CD (or an obvious variation thereof) and thus also are not patentable.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see the arguments regarding the validity of the cited RWM reference in the previous action, filed 21 November 2005, with respect to the rejection(s) of claim(s) 1 – 24 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Gorbet (U.S. Patent 6,072,480).

While it cannot be proven that the date given on the Raspberry world Music webpage precede Applicant's priority date, Examiner maintains the position that the knowledge taken from this cited document was notoriously well known in the art. Creating a mix CD (or tape or any other audio mix) for a person or group depending on their taste in music and an event (such as a birthday as stated in RWM) was very well known as it is more or less common knowledge and thus not patentable. While minor nuances in the invention may separate it from a mix CD as stated above, it is the Examiner's position that the currently presented claims (claims presented as of 21 November 2005) are broad enough in scope to read upon a mix CD and thus also are not patentable.

Portions of Applicant's arguments filed 21 November 2005 have been fully considered but they are not persuasive.

Applicant Alleges:

“Applicant respectfully submits that display of slides accompanied by computer generated music, is not equivalent to the DJ performance as claimed in the present invention. “

Examiner respectfully disagrees with this allegation. A disc jockey is defined as an individual who selects and plays prerecorded music for an intended audience (see Wikipedia.com definition of Disc Jockey). Applicants claim to have invented a virtual disc jockey (which would be an apparatus that simulates an individual who selects and plays prerecorded music for an intended audience). This is precisely what the system disclosed by Gorbet does. AS shown in the rejection, a slide presentation is geared towards its intended audience. In Gorbet, during playback of the electronic slide show, when each slide is displayed sound track songs are retrieved and played back, thus reading on the limitation of the Disc Jockey as claimed and intended by Applicant.

Applicant further alleges:

“The appearance of the slide is based entirely on the user's input. In other words, the display “performance” of the slide is exactly what the user inputs; i.e., the title, bullet mints, etc. However, in the present invention, the DJ performance is based on the client specific information and the DJ's performance, which is comprised, in part of a typical DJ improvisational performance, such as the DJ announcing the song title before playing the song, or stating that a song was number one in a certain year, was record of the year, performer of the year. Further, as made clear in new claims 25-28, the performance of the present invention

is arranged with and among event specific comments and musical performances "such that a DJ like performance related to the future event is fixed on the recording media". Gorbet does not disclose or suggest that its slideshow contains any of these elements. Therefore, the slideshow "performance" of Gorbet is not similar to the DJ performance of the present invention."

Examiner respectfully disagrees with this allegation. First Applicant is alleging that the fact that the slide is based entirely on the user's inputs excludes it from being a DJ performance. Examiner disagrees as the system displaying a slide show can read upon a DJ's performance as shown above in the previous argument. Further, Applicant states the DJ's performance is based on client specific information. A user (client) entering the information for the slide presentation as shown in col. 5 lines 55 – 60 of Gorbet reads upon this limitation. The user formats the slides as he or she wishes and then the system plays back the slides and music accompaniment..

Further, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., DJ's performance, which is comprised, in part of a typical DJ improvisational performance, such as the DJ announcing the song title before playing the song, or stating that a song was number one in a certain year, was record of the year, performer of the year) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicants statements that the performance of the present invention is arranged with and among event specific comments and musical performances “such that a DJ like performance related to the future event is fixed on the recording media” prove that Gorbet does not disclose or suggest that its slideshow contains any of these elements are invalid. As shown in the rejections below, event specific comments (i.e. sound bytes) are embedded within the slides; col. 6 lines 18 – 32, and musical performances are located in the slides (i.e. playing audio data; col. 6 line 25). All of the information is embedded within the presentation and thus the slide show presentation (i.e. DJ like performance) along with the sound bytes and audio data (i.e. event specific comments and musical performances) are all saved on the computer storage medium (i.e. a DJ like performance related to the future event is fixed on the recording media col. 5 lines 62 – 63).

### ***Claim Objections***

Claim 26 is objected to because of the following informalities: Claim 26 reads “...event specific materials.” which should not have a period as it creates a claim with 2 sentences. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 26, 27 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gorbet (U.S. Patent 6,072,480).

Regarding **Claim 25**, Gorbet discloses:

A virtual DJ (i.e. mechanism for playing custom music soundtracks to accompany an electronic slide show; col. 3 lines 66 – 67 and col. 43 line 1) comprising:

a recording media for recording information to be played at a future event (i.e. the slide presentation is generally stored on a computer medium; col. 5 lines 62 – 65 and the computer includes a CD drive for writing; col. 4 lines 54 – 670);

a collection of client selected, event specific materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motif's (*event specific material*), which are short music solos played whenever a predetermined event occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for



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example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting )); and

DJ performance materials arranged with and among event specific comments (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32), musical performances (i.e. playing audio data; col. 6 line 25) and the client selected, event specific materials (the author has selected and edited the slides and added the event specific materials as shown above) such that a DJ like performance related to the future event is fixed on the recording media (i.e. saving the slide show presentation allows the playback of an electronic slide show at a time in the future; col. 6 lines 18 – 32).

Regarding **Claim 26**, Gorbet discloses:

A method for performing recorded material at a future event (i.e. the slide show is recorded onto a CD for future playback; col. 6 lines 18 – 32 and col. 5 lines 62 – 63), the method comprising:

gathering client selected event specific materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motif's (*event specific material*), which are short music solos played whenever a predetermined event occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for

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example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting ));

producing a recorded DJ like performance related to the future event (i.e. an electronic slide show; col. 6 lines 18 – 32) by arranging a DJ's performance material with and among event specific comments (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32) musical performances (i.e. playing audio data; col. 6 line 25) and the client selected, event specific materials(the author has selected and edited the slides and added the event specific materials as shown above);

storing the recorded DJ like performance on media (i.e. stored on a computer storage medium; col. 5 lines 62 – 63 such as a CD-ROM col. 4 lines 55 – 60); and

playing the recorded performance at the future event (i.e. the saved performance may be played back at any time or event in the future).

Regarding **Claim 27**, Claim 27 is rejected under the same grounds as claim 26 above.

Regarding **Claim 28**, Gorbet discloses:

A media for broadcast at a future event (i.e. a slide presentation stored on a computer storage medium; col. 5 lines 62 – 63 such as a CD-ROM col. 4 lines 55 – 60), material fixed on the media comprises:

a selection of client selected, event specific materials (i.e. the author (*client*) selects and edits slides; col. 5 lines 60 – 63; and the slide show may have motifs (*event specific material*), which are short music solos played whenever a predetermined event occurs; col. 9 lines 40 – 42; (although not explicitly relied upon for this rejection, it is noted that the event specific materials may be the content of the slide show, for example a corporations quarterly earnings meeting slide show presentation would be programmed with information specific to that meeting )); and

DJ performance materials arranged with and among event specific comments (i.e. the slide show program includes code for controlling an electronic slide show (*DJ performance materials*); and a sound clip that is embedded in a slide (*event specific comments*); col. 6 lines 18 – 32), musical performances (i.e. playing audio data; col. 6 line 25) and the client selected, event specific materials (the author has selected and edited the slides and added the event specific materials as shown above) such that a DJ like performance related to the future event is fixed on the recording media (i.e. saving the slide show presentation allows the playback of an electronic slide show at a time in the future; col. 6 lines 18 – 32).

Regarding **Claim 2**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media is an audio media (i.e. the media is a CD-ROM which includes a slide show with audio on it).

Regarding **Claim 3**, in addition to the elements stated above regarding claim 25,  
Gorbet further discloses:

wherein the media is audio and visual (i.e. the slide show displays a slide and plays audio data; col. 6 lines 18 - 32).

Regarding **Claim 5**, in addition to the elements stated above regarding claim 25,  
Gorbet further discloses:

wherein the media is a compact disc (i.e. a CD-ROM; col. 4 lines 55 – 60).

Regarding **Claim 6**, in addition to the elements stated above regarding claim 25,  
Gorbet further discloses:

wherein the media is a compact disc read only memory (i.e. a CD-ROM; col. 4 lines 55 – 60).

Regarding **Claim 7**, in addition to the elements stated above regarding claim 3,  
Gorbet further discloses:

wherein the media includes pictures for display at the future event (i.e. the slide show col. 4 lines 5 – 10).

Regarding **Claim 8**, in addition to the elements stated above regarding claim 3,  
Gorbet further discloses:

wherein the media includes a slide show for display at the future event (i.e. the slide show col. 4 lines 5 – 10).

Regarding **Claim 9**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media includes songs from a play list (i.e. the user selects one of three custom soundtrack options; col. 8 lines 15 – 20).

Regarding **Claim 11**, in addition to the elements stated above regarding claim 25, Gorbet further discloses:

wherein the media includes software to enable a display of visual effects synchronized with audio portions of the DJ performance materials (i.e. a slide show presentation; col. 6 lines 18 – 32).

Regarding **Claim 15**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

where the arrangement of the recorded performance is based on in part an event itinerary (i.e. the slide show is inherently an itinerary for a presentation, the music soundtrack is associated with the slides and thus the arrangement is based upon them; col. 8 lines 15 – 20).

Regarding **Claim 16**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

an event client providing pertinent information regarding the future event (i.e. the author edits the performance and thus inserts pertinent information for the presentation which is to be viewed at a future event; col. 5 lines 55 – 67 and col. 6 lines 1 – 5).

Regarding **Claim 17**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

providing an event client the recorded performance in a media (i.e. the slide show is saved on a CD as shown above).

Regarding **Claim 21**, in addition to the elements stated above regarding claim 27, Gorbet further discloses:

wherein said gathering means includes an Internet web site having an input configured to receive client related material provided by an event client (i.e. means for connecting to the internet; col. 5 line 49; and in a networked environment, program modules depicted relative to the personal computer, or portions thereof, may be stored in the remote memory storage device; col. 5 lines 50 – 53)

Regarding **Claim 22**, in addition to the elements stated above regarding claim 27, Gorbet further discloses:

wherein the playing means includes a computer (Fig. 1)

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10, 13, 14 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480).

Regarding **Claim 10**, in addition to the elements stated above regarding claim 25 Gorbet further discloses:

wherein the client selected, vent specific material includes information (i.e. a slide may also comprise other information; col. 6 lines 4 – 5).

Gorbet doesn't explicitly state that the other information is guest information, however, it is well known that slide show presentations, such as Power Point presentations are geared toward their audience (see the Wikipedia.com document for

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Power Point), thus the author must inherently have information about the guests. For example, an English professor (an educator as shown in Wikipedia.com) may have a presentation for display to his students related to Shakespeare. Thus, the slide show is geared to the students (*guests*).

Creating a slide show geared towards the viewers is desirable to keep their interest during playback.

Regarding **Claim 13**, in addition to the elements stated above regarding claim 26, Gorbet further discloses:

wherein the gathering of client selected, event specific material is in response to a play list and information (i.e. the author edits the slides; col. 5 lines 58 – 62; and the author selects one of three custom soundtrack options; col. 8 lines 15 – 20).

Gorbet doesn't explicitly state that the other information is guest information, however, it is well known that slide show presentations, such as Power Point presentations are geared toward their audience (see the Wikipedia.com document for Power Point), thus the author must inherently have information about the guests. For example, an English professor (an educator as shown in Wikipedia.com) may have a presentation for display to his students related to Shakespeare. Thus, the slide show is geared to the students (*guests*).

Creating a slide show geared towards the viewers is desirable to keep their interest during playback.



Regarding **Claim 14**, in addition to the elements stated above regarding claim 13, Gorbet fails to disclose wherein the guest information includes stories and idiosyncrasies.

However, from the example shown in claim 13, the slide presentation of an English professor using the Power Point program would inherently contain stories and idiosyncrasies.

Regarding **Claim 19**, in addition to the elements stated above regarding claim 17, the combination of Gorbet in view of RWM fails to disclose accepting a security deposit from the event client prior to the step of providing. However, Examiner takes official notice that taking a security deposit prior to providing goods or services is notoriously well known in the art. One would have been motivated to accept a security deposit prior to the step of providing in order to ensure the items given out were returned in a usable condition.

**Claims 4, 18 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorbet (U.S. Patent 6,072,480) in view of Bakos (U.S. Patent 6,511,728).

Regarding **Claims 4, 18 and 24**, in addition to the elements stated above regarding claims 25, 17 and 28, Gorbet doesn't disclose wherein the media has a predetermined life span.

Bakos discloses an optical media that can only be used for a limited period of time; col. 2 lines 63 – 67.

It would have been obvious to one of ordinary skill in the art at the time of the invention to record the slide show onto a CD with a limited life as disclosed by Bakos. One would have been motivated to do so in a situation where the slide show on the CD was a demo; see Bakos lines 45 – 50.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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